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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,649	03/09/2001	Akira Yoda	2091-0234P	3948
2292	7590	10/06/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			THOMPSON, JAMES A	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/801,649	<b>Applicant(s)</b> YODA, AKIRA	
	<b>Examiner</b> James A Thompson	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the date of the foreign priority document is incorrect. The date should be 03/09/2000 and not 09/03/2000 as the date is currently written.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US Patent 5,850,481) in view of Kenner (US Patent 5,956,716).

Claims 1-5 recite an image output method. Claims 6-10 recite an image output apparatus. Claims 11-15 recite a computer-readable recording medium storing a program to cause a computer to execute a method. The image output apparatus of claims 6-10 perform the image output method of claims 1-5 and the steps of the computer program of claims 11-15. Claims 1-5, claims 6-10, and claims 11-15 are therefore respectively discussed together.

**Regarding claims 1, 6 and 11:** Rhoads discloses an image output apparatus (figure 6 of Rhoads) comprising reading means (figure 6(218) of Rhoads) for obtaining initial image data (column 17, lines 58-63 of Rhoads) representing an initial (suspect) image recorded in an original image (column 19, lines 6-12 of Rhoads) and ID information for identifying an original picture by reading the original image (column 16, lines 6-10 of Rhoads) having the original picture and the ID information inseparable from the original picture (column 12, lines 10-16 of Rhoads). In order to obtain the image with the embedded N-bit identification word (column 16, lines 6-10 of Rhoads), it is inherent that said image is read. Otherwise, there would be no image data from which to determine said N-bit identification word. Since the embedded identification number can be retrieved independent of whether operations such as scaling, cutting, and registering are performed on the image (column 12, lines 10-16 of Rhoads), then said identification information is clearly inseparable from the original picture.

Said apparatus further comprises storage means (figure 6(214) of Rhoads) for storing a plurality of sets of original picture data samples in relation to ID information (column 22, lines 21-22 and lines 25-30 of Rhoads).

Said apparatus further comprises reading means for reading equivalent original picture data representing an equivalent original picture (column 18, lines 64-67 and column 19, lines 14-15 of Rhoads) corresponding to the ID information of the original picture from the storage means (column 22, lines 21-22 and lines 25-30 of Rhoads). Since data samples of the original picture data are stored in memory (column 22, lines 21-22 and lines 25-30 of Rhoads) and used in a matching process with the suspect image (column 18, lines 64-67 and column 19, lines 14-15 of Rhoads), a reading means for reading said stored original data is inherent in the device. Otherwise, said stored original data would not be available for use in said matching process.

Said apparatus further comprises processing means (figure 6(202); and column 17, lines 46-48 and lines 53-55 of Rhoads) for obtaining processed image data by comparing the initial image data with the equivalent original picture data (column 18, line 64 to column 19, line 2 of Rhoads) and carrying out processing on the equivalent original picture data to cause the equivalent original picture data to geometrically agree with the original picture in the initial image (column 19, lines 14-17 and column 7, lines 35-39 of Rhoads).

Said apparatus further comprises output means (figure 6(234) and column 18, lines 43-44 of Rhoads) for obtaining a print by printing the processed image data (column 18, lines 53-55 of Rhoads).

Rhoads does not disclose expressly that said storage means stores, in relation to ID information, the entire original picture of each of said plurality of sets of original picture data.

Kenner discloses storing the entire clip of video data along with its related identification (video ID) information for each of a plurality of video data clips (column 28, lines 46-54 of Kenner).

Rhoads and Kenner are combinable because they are from similar problem solving areas, namely the prevention of unauthorized data copying. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store all of the data, along with the corresponding identification code, as taught by Kenner, said data being the image data taught by Rhoads. The motivation for doing so would have been to allow the original content provider to modify the content as desired (column 28, lines 40-45 of Kenner) and keep track of the different versions of the content (column 28, lines 12-15 of Kenner). Therefore, it would have been obvious to combine Kenner with Rhoads to obtain the invention as specified in claims 1, 6 and 11.

**Regarding claims 2, 7 and 12:** Rhoads discloses that the ID information is secretly embedded in the initial image (column 5, lines 38-41 of Rhoads). Since the ID information that is embedded in the initial image has the look of pure noise (column 5, lines 38-41 of Rhoads), the said ID information is clearly embedded secretly.

**Regarding claims 3-4, 8-9, and 13-14:** Rhoads discloses examining an image that potentially infringes upon a copyright (column 10, lines 48-52 of Rhoads) and comparing said infringing image with the original image (column 11, lines 55-64 of Rhoads) to determine if copyright infringement has indeed occurred (column 10, lines 53-55 of Rhoads).

Rhoads does not disclose expressly copying prevention processing means for carrying out processing to prevent copying on the processed image data and/or on the print.

Kenner discloses copying prevention processing means (figure 4(58) of Kenner) for carrying out processing (column 25, lines 55-62 of Kenner) to prevent copying on the processed image data and/or on the print (column 25, lines 64-67 and column 26, lines 10-13 of Kenner).

Rhoads and Kenner are combinable because they are from similar problem solving areas, namely the prevention of unauthorized data copying. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a copying prevention means, as taught by Kenner, based on the embedded copy prevention data taught by Rhoads. The motivation for doing so would have been to deter unauthorized copying and better enable the authorities to track down copyright violators (column 26, lines 9-11 of Kenner). Therefore, it would have been obvious to combine Kenner with Rhoads to obtain the invention as specified in claims 3-4, 8-9, and 13-14.

**Regarding claims 5/1-5/4, 10/6-10/9, and 15/11-15/14:** Rhoads does not disclose expressly information management means for managing a copyright of the original picture based on the ID information.

Kenner discloses information management means (figure 4(90) of Kenner) for managing a copyright of the original picture based on the ID information (column 28, lines 46-52 of Kenner).

Rhoads and Kenner are combinable because they are from similar problem solving areas, namely the prevention of unauthorized data copying. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to manage the copyright information based on the ID information, as taught by Kenner. The motivation for doing so would have been to be able to properly manage the distribution of copyrighted data (column 28, lines 52-58 of Kenner). Therefore, it would have been obvious to combine Kenner with Rhoads to obtain the invention as specified in claims 5/1-5/4, 10/6-10/9, and 15/11-15/14.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Xin Wen, US Patent 6,647,126 B1, 11 Nov. 2003, filed 28 January 2000.

Geoffrey B. Rhoads, US Patent 6,345,104 B1, 5 Feb. 2002, filed 31 July 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Thompson whose telephone number is 703-305-6329. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703-308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson  
Examiner  
Art Unit 2624

JAT  
27 September 2004



THOMAS D.  
~~TOMPKINS~~ LEE  
PRIMARY EXAMINER